

## **REMARKS**

Claims 1-10, 14-16, 18-23 and 57-66 are currently pending. Claims 67 and 68 have been added.

### **Fees**

It is not believed that any further fees are necessary at this time. However, in the event additional fees are required, Applicants authorize the Commissioner to take any necessary fees, including those under 37 CFR 1.16 and 1.17, from deposit account 50-0913.

### **A Brief Review of One Embodiment of Applicants' Invention**

In one embodiment of Applicants' invention, a gaming device includes a housing with several walls that define a cavity. A moveable indicator is associated with the housing. A moveable indicator actuator is configured to move the moveable indicator in a linear manner along a first axis. A display device is associated with the housing. The display device includes a band displaying indicia. A display device actuator is configured to move the band in a linear manner along a second axis. The second axis is orthogonal to the first axis. A controller is in communication with the display device actuator and the moveable indicator actuator. The controller determines a game outcome and directs movement of the moveable indicator and the band.

### **Rejection under 35 U.S.C. § 103**

The Office rejected claims 1-10, 14-16, 18-23 and 57-66 under 35 U.S.C. §103(a) as being unpatentable over Nordman (U.S. Patent 6,712,694) in view of Brown (U.S. Patent

Number 5,673,504). Nordman allegedly discloses a gaming device with rotating display and indicator therefore. Brown allegedly discloses a tape display device.

Neither Nordman nor Brown anticipates the claims of the present invention for at least the following reasons:

- No reference has been cited showing indicia mounted on a moving band.
- The combination of Nordman and Brown is not obvious.
- The combination of Nordman and Brown can only be gleaned through hindsight reasoning.
- The cited reference to Brown is non-analogous art.
- The cited references do not teach, disclose or suggest a player input device that allows a player to control and direct the movement of either the indicator or the band.
- The cited references do not teach, disclose or suggest a continuous band.

#### **No reference has been cited showing indicia mounted on a moving band**

Independent claims 1, 57 and 62 recite a band that has a plurality of indicia thereon. The Office has failed to cite any references that teach, disclose or suggest, indicia mounted on a moveable band of material. Page 3, line 4 of the Office Action states, “It is old and well known to place indicia on a moving band of material”; however, no references are cited to support this rejection. Applicants disagree that it is well known to place indicia on a moving band in the way that the applicants have in the claimed invention. Simply stating that it is well known does not make it so. The Office must provide evidence that it is known in this art. Therefore, the

proposed combination of elements of the cited references does not yield the present invention as claimed.

**The combination of Nordman and Brown is not obvious.**

In order to establish prima facie obviousness, the Examiner must provide a clear explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification (see MPEP 706.02(j)).

Rejections on obviousness grounds cannot be sustained by mere conclusionary statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) cited with approval in *KSR Int'l. Co. v. Teleflex Inc.* 127 S. Ct. 1727, 1740-1741, 82 USPQ 2d 1385, 1396 (2007).

Applicant respectfully submits that there is no motivation or suggestion in either Nordman or Brown or a reason articulated to modify Nordman to include a tape as taught by Brown and that the claims are patentably distinguishable over the art of record.

**The combination of Nordman and Brown can only be gleaned through hindsight reasoning.**

The Federal Circuit has also stated that either a showing of some objective teaching in the prior art or the knowledge generally available to one of ordinary skill in the art must lead an individual to combine the relevant teachings of the references. *In Re Fine*, 837 F2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (citing *In Re Lahu*, 747 F2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). A rejection based on §103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this

evaluation, there is an initial burden of supplying the factual basis for the rejection advanced. One may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. See *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967).

It is doubtful that one skilled in the art of designing casino games would be motivated or inclined to look at gas station signs for use with casino wagering devices.

As described above, and because Nordman or Brown both fail to recognize the problems solved by the present invention, it would appear that the Examiner's obviousness determination was reached only after having considered the subject of Applicant's invention rather than the teachings of the prior art or the knowledge of those of ordinary skill in the art.

Because the cited references do not teach, disclose or suggest all limitations of Applicant's claims, Applicants respectfully request the Office to withdraw the §103(a) rejection.

#### **The cited reference to Brown is non-analogous art**

The present invention is related to gaming devices. Conversely, Brown is from the art of gas service station signs and, more specifically, in the area of an automatic petroleum sign. One skilled in the art of designing gaming devices, acting in a logical, common sense manner would not be motivated to look in the field of gas station signs when designing new casino games.

Prior art references must either be in the field of the inventor's endeavor or reasonably pertinent to the specific problem with which the inventor was involved. The references relied upon must be in an art that is analogous to that of the invention. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986).

The courts have clearly explained that the references must have been available to the inventor as follows:

*In resolving the question of obviousness under 35 U.S.C. §103, we presume full knowledge by the inventor of all the prior art in his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. The rationale behind this rule precluding rejections based on combinations of teachings of references from non-analogous arts is the realization that an inventor could not possibly be aware of every teaching in every art. In re Wood, 599 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979).*

Since Brown relates to gas station signs, it is non-analogous art and it should not be used in a rejection of the present application. Therefore, the Office has failed to establish prima facie obviousness.

**The cited references do not teach, disclose or suggest a player input device that allows a player to direct the movement of either the indicator or the band.**

Dependent claims 2, 58 and 63, recite a player input device that is coupled to the housing and is in communication with the controller. The player input device allows a player to direct the movement of either the indicator or the band.

Nordman does not teach, disclose or suggest the use of a player input device that allows a player to direct the movement or control the position of the indicator or the band.

Nordman does not teach, disclose or suggest the use of a player input device that allows a player to dictate the position of a band or an indicator. Page 3, of the Office Action refers to a handle, buttons and a touch screen as shown in figure 2 of Nordman as player input devices.

As recited in column 4, lines 62-67 and column 5, lines 1-11 of Nordman, "a player can start the game by pulling arm 18 or pushing play button 20.....gaming device 10 includes a bet display 22 and a bet one button 24. The player places a bet by pushing the bet one button 24.

The player can increase the bet by one credit each time the player pushes the bet one button 24.....The player may cash out by pressing a cash out button 26". Column 6, lines 14-15 of Nordman states, "the touch screen enables a player to input decisions into the gaming device 10".

There is no disclosure, teaching or suggestion in Nordman of allowing the player to control the position of display 60 or indicator 80. None of the input devices of Nordman allow a player to control any function in the bonus game. The handle, buttons and touch screen of Nordman merely allow the player to start and cash out of the primary slot game. The handle, buttons and touch screen of Nordman do not allow the player to control any part or function of the secondary or bonus game.

**The cited references do not teach, disclose or suggest a continuous band**

The alleged combination of cited references fails to anticipate new claims 67 and 68 of the present invention. Claims 67 and 68 recite that the moveable band is continuous.

In contrast, the cited reference to Brown teaches away from the present invention. Brown discloses a tape 14 that has two ends. Each end is wrapped around a roller 11, 12 (see figure 2 and column 2, lines 28-39 of Brown). The tape of Brown has to travel back and forth in a reel to reel manner. The tape of Brown is not continuous and cannot travel in a continuous loop.

Because the cited references do not teach, disclose or suggest all limitations of Applicants' claims, Applicants respectfully request the Office to withdraw the §103(a) rejection.

## **Conclusion**

For all of the above reasons, the Applicants submit that the present application is in condition for allowance. If the Examiner has any questions regarding the application or amendment, the Examiner is encouraged to call the Applicants' attorney at (775) 826-6160.

Respectfully Submitted,

/ian f burns/

---

Ian F. Burns  
Attorney for Applicant  
Registration Number: 33,297